

REMARKS

Claim 21 and all dependent claims (claims 22-32, 34 and 37-42) have been canceled. Claims 1, 3-20, 35, 36 and 43-47 remain pending.

The Office Action rejected claims 1, 3-20, 35, 36 and 43-47 under 35 U.S.C. § 103 as obvious over U.S. patent 6,306,407 ("Castro") in view of U.S. patent 5,814,322 ("Sebillotte-Arnaud"). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The Examiner has recognized that Castro fails to disclose the claimed active agents useful for treating greasy skin set forth in claim 1. To compensate for this critical deficiency, the Examiner has asserted that one skilled in the art would have been motivated to combine Sebillotte-Arnaud's active agents with Castro's compositions to yield the claimed invention. As set forth below, this reasoning is flawed: no motivation would have existed to combine Sebillotte-Arnaud's active agents with Castro's compositions. Accordingly, the § 103 rejection is improper and should be withdrawn.

Simply stated, the Examiner's combination of Sebillotte-Arnaud's active agents with Castro's compositions is exactly the type of combination which Sebillotte-Arnaud had found to be problematic and which Sebillotte-Arnaud was trying to avoid. Thus, not only is this combination of references improper because it would render the references unsuitable for their intended purposes (see, MPEP § 2143.01), but it is also improper because Sebillotte-Arnaud teaches away from it.

Castro's fibers are present in an oil carrier. (Col. 4, line 19 et seq.). Moreover, Castro generically suggests adding oil-soluble active agents to his compositions, but not water-soluble active agents. (Col. 6, line 37). Thus, Castro discloses compositions (for

example, emulsions) in which fibers and “active agents” (if present) are in the oil phase or an oil carrier.

Sebillotte-Arnaud states that the purpose of his invention is to provide a stable active agent-containing composition. Sebillotte-Arnaud notes that problems exist with conventional active agent-containing compositions such as emulsions, stating that “it is often difficult, indeed even impossible, to incorporate certain active agents such as kojic acid, caffeic acid, salicylic acid ...” into conventional cosmetic compositions. (Col. 1, lines 25-34). Sebillotte-Arnaud’s solution to this problem is a gel composition containing a hydrophilic medium or carrier, not a conventional oil-containing composition such as an emulsion. (See, abstract). These active agent-containing gel compositions are described as being stable.

Given that Sebillotte-Arnaud found that his active agents were stable in a gel containing a hydrophilic carrier but were not stable in other types of compositions, one skilled in the art would not have been motivated to use such active agents in a composition which did not possess a hydrophilic carrier because no expectation would have existed that the resulting active agent-containing composition would be stable. In other words, one skilled in the art would not have been motivated to use Sebillotte-Arnaud’s active agents in a composition containing an oil carrier because no expectation would have existed that these active agents would have been stable in such a composition. Thus, one skilled in the art would not have been motivated to combine Sebillotte-Arnaud’s active agents with Castro’s oil-containing compositions.

Because no motivation would have existed to combine Sebillotte-Arnaud with Castro, the §103 rejection is improper.

In the most recent Office Action, the Examiner asserted (at page 7) that (1) the motivation to combine Sebillotte-Arnaud and Castro comes from Castro’s desire to control oily skin; (2) Castro relates to any type of composition, not just emulsions; and (3) Sebillotte-

Arnaud was cited as merely supporting art to show that the named active agents are known in the art. Applicant respectfully submits that the above arguments address each of the points raised by the Examiner and/or renders them moot. Castro's merely desiring to control oily skin or generally stating that any type of composition will suffice is completely insufficient to overcome Sebillotte-Arnaud's teachings that his active agents should be in a hydrophilic medium. No motivation exists to combine Sebillotte-Arnaud's active agents with Castro's compositions. In this regard, Sebillotte-Arnaud is critical to the rejection, as it is the only evidence applied disclosing certain active agents. Sebillotte-Arnaud cannot be used "selectively" – it must be taken as a whole for what it teaches. As shown above, the references teach away from the claimed combination.


In view of the above, Applicant respectfully requests that the rejection under § 103 be reconsidered and withdrawn.

Application No. 09/847,388
Response to Office Action dated August 19, 2003

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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